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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,080	12/22/2000	Chieko Aoki	0229-0629P	6967

7590

02/13/2003

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 02/13/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/742,080

Applicant(s)

AOKI ET AL.

Examiner

Geoffrey L. Knable

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SM

#5

-- The MAILING DATE of this communication appears on the cov r sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8-12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

1. Claims 1, 8-12 and 14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 has been amended to define that the noise damper is a foamable liquid including an emulsion of an elastomer and a surfactant. It however is not considered that the original disclosure describes the invention in this manner in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is considered to be new matter. In particular, the specification and original claims describe the liquid damper as either (1) liquid such as water; (2) an emulsion of e.g. an elastomer; or (3) a foamy solution of for example water and surfactant. The specification also indicates that the foamy solution, i.e. (3), can be a rubber latex in the form of a foam. The original disclosure however does not describe or reasonably support now defining that the noise damper is a foamable liquid including an emulsion of an elastomer and a surfactant. The only discussion of an emulsion of an elastomer, i.e. liquid damper (2), does not ever describe that it be "foamable" or include a surfactant. The closest original description of the now claimed damper liquid seems to be the disclosure of a rubber latex in the form of a foam – this however does not describe additional inclusion of a surfactant and further does not clearly support the reference to an "emulsion of an elastomer".

Along similar lines, the original disclosure also does not describe the inclusion of a "foam stabilizer" with such a mixture as required by dependent claim 8, it being noted that the original disclosure only describes use of a foam stabilizer in the context of a "water base foamy solution", i.e. water and surfactant. This is thus not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is also considered to be new matter.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pace (US 3,361,698) alone or taken with Jones et al. (US 5,366,601 – newly cited).

Pace is applied for substantially the same reasons as set forth in the last office action. As to the new requirement for a foamable elastomer emulsion with surfactant, it is again noted that Pace suggests that elastomer materials may be dispersed in liquid – note esp. col. 8, lines 10+. Further, this reference indicates that the liquid sealant include what is described as a "dissolution agent" such as di-n-butylamine – note esp. col. 5, lines 52+ as well as col. 8, lines 10+. It would seem reasonable from this discussion to describe this mixture as an emulsion and further di-n-butylamine is considered to be a "surfactant" (e.g. note col. 5, lines 40-43 of Jones et al.). As to the description of the material as "foamable", it is considered very likely that such a mixture

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would be expected to be *capable of* being made to foam if treated sufficiently – note that the claim defines that the material is “foamable”, not that it is a foamed.

4. Claims 9-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pace (US 3,361,698) alone or taken with Jones et al. (US 5,366,601 – newly cited) as applied to claim 1 above, and further in view of EP 753420 to Gerresheim et al. applied for the same reasoning as set forth in the last office action.

5. Applicant's arguments filed 11-26-02 have been fully considered but they are not persuasive as they are essentially moot in light of the new grounds of rejection necessitated by the amendments to the claims presenting a combination of features that was not before claimed.

Additionally, it is noted for the record that the previous rejection over the patent to Nishikawa (US 6,343,843) was withdrawn in light of the amendments to the claims, and not, contrary to one of applicant's argument, because applicant's foreign priority date predates this reference. This is because, as set forth in the last office action, “applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15,” this translation being necessary in order to ensure that the priority document supports or describes what is claimed.

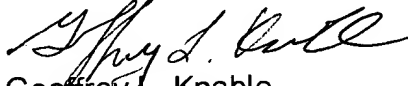
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 703-308-2062. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
February 6, 2003